

In regards to the references not considered in the Information Disclosure Statement, the Examiner stated in the Office Action dated December 20, 2002 that non-considered references will be considered in the next Office Action. Also, Applicants request consideration of the Supplemental Information Disclosure Statement filed on September 25, 2002, as it cites the patent from an application referenced in the specification paragraph bridging pages 6 and 7.

Claim 30 was rejected under 35 U.S.C. §102(b) in view of U.S. Patent No. 3,904,781 (Henry). Claim 30, as amended, describes restraining tissue in a container against a surface in a fixed orientation. Henry has a well upon a slide having a cellular sample in a liquid, or a suspension of cells (see Abstract, and column 2, lines 53-62). Such cells thus cannot be in a fixed orientation by virtue of their floating in a liquid. Even when the suspension medium is removed as described in Henry (see e.g., column 3, lines 36-46) the cells are still not clamped upon its slide in a fixed orientation. Thus, Henry does not anticipate Claim 30.

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Henry in view of U.S. Patent No. 4,545,831 (Ornstein). Henry fails to describe or suggest any means for clamping tissue upon a tray in a fixed orientation. Cells in a liquid before or after the liquid is removed are not clamped in a fixed orientation upon Henry's slide. The Ornstein method of transferring a thin tissue specimen does not provide that which is absent in Henry. Thus, Claim 9 is patentable over Henry and Ornstein, either alone or in combination.

Claims 10, 11, 23, and 24 were rejected as unpatentable over Henry et al., and one of U.S. Patent No. 5,870,223 (Tomimatsu), U.S. Patent No. 1,991,983 (Newman), or U.S. Patent No. 1,002,910 (Foote). Claims 10, 11, 23 and 24 depend on Claim 9, which for reasons argued above is patentable over Henry. Tomimatsu describes a microscope for observing a specimen in an immersion liquid. Newman describes a microscope slide. Foote describes a display mount unrelated to imaging tissue, but rather for mounting natural history specimens (see column 1, lines 10-39, of Foote). Neither of Tomimatsu, Newman, or Foote describe such means for clamping absent in Henry, thus Claims 10, 11, 23 and 24 are believed patentable over the combination of Henry and either Tomimatsu, Newman, or Foote.

Claims 34-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Henry in view of Foote. Claims 34-35 depend on Claim 30 which for reasons argued above is patentable over Henry. Foote fails to describe or suggest that missing in Henry for restraining tissue in a container against a surface in a fixed orientation. Moreover, Foote does not describe imaging tissue, but is merely a display box for mounting natural history specimens. No motivation or suggestion is present as to why one would combine a natural history specimen display mounting

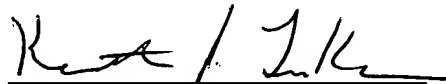
box of Foote with Henry's well and slide for cells in suspension, as they deal with different types of specimens on a completely different scale. Accordingly, Claims 34-35 are believed patentable over the combination of Henry and Foote.

Claims 21, 22 and 31-33 were rejected as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 21 and 31 have been rewritten with respective base Claims 9 and 30. Thus, Claims 21 and 31 should be allowable. Claims 22 and 32-33 should be allowable as being dependent on allowable Claims 21 and 31, respectively.

Claims 25-29 have been allowed.

In view of the above, withdrawal of the rejections to the claims are requested as the application is believed to be in condition for allowance. A petition for a three-month extension of time is enclosed with a check for the \$465.00 petition fee.

Respectfully submitted,



Kenneth J. LuKacher
Attorney for Applicant(s)
Registration No. 38,539

Dated: January 31, 2003

South Winton Court
3136 Winton Road South, Suite 204
Rochester, New York 14623
Telephone: (585) 424-2670
Facsimile: (585) 424-6196

Enclosures: Appendix with marked-up version of amended specification and claims;
Petition for Extension of Time with check for \$465.00;
Drawing Sheet for FIG. 4A; and
Certificate of Mailing by Express Mail, Express Mail No. EV 104334700US.

APPENDIX

Marked-up version of amended specification and claims.

In the Specification

Please replace the first paragraph on page 1 as follows:

This application is a divisional of U.S. Patent Application Serial No. 09/506,135, filed February 17, 2000, now U.S. Patent No. 6,330,106, which claims the priority benefit of U.S. Provisional Application No. 60/120,470, filed February 17, 1999, which is herein incorporated by reference.

Please replace the paragraph at page 6, line 21, to page 7, line 9, as follows:

When the tissue specimen 34 is placed in the tray in the base 26 and over the window 32 as shown in FIGS. 3 and 4, the specimen 34 is held down by the clamp mechanism 40 in a fixed orientation. The clamp mechanism which is illustrated has hooked or barbed fingers which are hinged to the sidewalls 28 at spaced locations. The mechanisms include springs 42 which provide over center locks, such that when the fingers are pressed down beyond their axis of rotation, they are held down by the springs 42. Other clamping mechanisms may be used to hold down the specimen in a fixed orientation such as meshes or a membrane overlay 40A or a permeable or perforated bag (FIG. 4A). Fiducial marks, which can be visualized or imaged, may be provided in the case of meshes or membranes. The use of a membrane or mesh may be preferable since the specimen 34 may be moved under the membrane. The membrane specimen tray or cassette is the subject matter of a companion application filed concurrently herewith in the name of Bill Fox, et al., U.S. Provisional Application No. 60/120,534, filed February 17, 1999, now [pending as] U.S. Patent No. 6,411,434, issued June 25, 2002, from U.S. Patent Application No. 09/502,252, filed February 17, 2000. Further information as to the use of the markings on the clamping mechanism (the mesh or membrane) to mark locations of the image tissue is contained in a co-pending International Patent Application No. PCT/US99/21116, and U.S. Patent Application, filed in the names of Roger J. Greenwald and James M. Zavislan, serial number 60/100,176, filed September 14, 1998, now pending as U.S. Patent Application No. 09/786,902, filed March 9, 2001, having priority to U.S. Provisional Application No. 60/100,176 through International Patent Application No. PCT/US99/21116. The purpose of the clamps is to

keep the tissue stationary during examination and also provide a means to lightly compress the tissue surface against the window. Alternatively, the clamps may provide tension to pull the tissue surface taut. Holding the tissue with either compression normal to the window or in tension parallel to the window (or both) tends to reduce the surface texture, or corrugation, peak to valley depth.

In the Claims:

Please amend Claims 9, 21, 30, and 31 as follows:

9. (twice amended) An apparatus for imaging excised tissue having a refractive index comprising:

a tray upon which excised tissue is disposed;

means for clamping said excised tissue upon said tray in a fixed orientation; and

optics directed towards the excised tissue through a portion of said tray in which said tray contains an immersion media having a refractive index matching the refractive index of said excised tissue.

21. (amended) An apparatus for imaging excised tissue having a refractive index comprising:

a tray upon which excised tissue is disposed;

means for clamping said excised tissue upon said tray; and

optics directed towards the excised tissue through a portion of said tray in which said tray contains an immersion media having a refractive index matching the refractive index of said excised tissue, [The apparatus according to Claim 9] wherein said clamping means represents one or more fingers capable of holding said excised tissue upon said tray.

30. (amended) A method for imaging excised tissue comprising the steps of:

providing a container having a surface for placement of said tissue;

restraining said tissue in said container against said surface in a fixed orientation; and

imaging said tissue [specimen] through at least part of said surface of said container.

31. (amended) A method for imaging excised tissue comprising the steps of:

providing a container having a surface for placement of said tissue;

restraining said tissue in said container against said surface; and

imaging said tissue through at least part of said surface of said container, [The method according to Claim 30] wherein said restraining step is carried out with the aid of one or more members extending into said container.